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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re J. Russell Phelps

Serial No. 76274519

John Burton, Esq. for J. Russell Phelps.

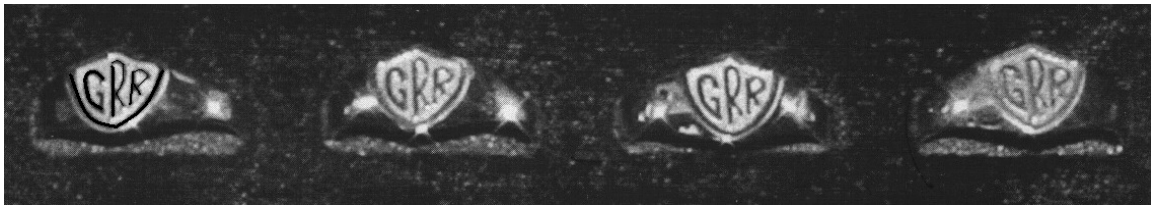
LaVerne T. Thompson, Trademark Examining Attorney, Law
Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Hohein, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On June 21, 2001, J. Russell Phelps (an individual
U.S. citizen) filed an application to register the mark GRR
on the Principal Register for "jewelry" in International
Class 14. The application was based on applicant's
assertion of a bona fide intention to use the mark in
commerce. The mark was published for opposition on
November 13, 2001; and a Notice of Allowance issued on
February 5, 2002. Applicant filed a Statement of Use on

March 22, 2002, along with one specimen, alleging a date of first use of June 8, 2001 and a date of first use in commerce of March 15, 2002. The original specimen is a photograph of a jeweler's ring tray, with several empty slots and several slots holding gold rings with GRR marked thereon, as shown below:



With its August 12, 2002 response to the first Office action, applicant submitted a second specimen in the form of one actual gold ring with GRR thereon.¹

The Examining Attorney refused registration under Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127 of the Trademark Act, on the ground that the proposed mark is

¹ Applicant requested that the actual ring specimen be returned to applicant if possible. (Applicant's August 29, 2002 response to first Office action, p. 2.) The USPTO discourages the filing of bulky specimens as explained in Trademark Rule 2.56(d) and TMEP §904.03 (3d ed. 2002). When bulky specimens are filed the USPTO will generally create a facsimile that meets the requirements and destroy the original bulky specimen. That was not done in this case and the actual ring is currently in the file.

Applicant is advised that the actual ring specimen forms part of the record and must remain with the application file until the case is finally decided including any appeals of the final Board decision. Thereafter, when the Board case is terminated, the Board will certainly attempt to have the actual ring returned to applicant's attorney. (The Board does not pay the cost of insuring any mail that it sends out.)

merely ornamental and does not function as a mark as used on the goods.

When the refusal was made final, applicant appealed. Briefs have been filed. Applicant did not request an oral hearing.

Applicant contends that his mark GRR is inherently distinctive, and is not mere ornamentation or background design; that the mark is a combination of three distinctive source indicating letters, and it "creates a separate commercial impression that identifies the product and distinguishes it from those sold by others" (brief, p. 2); that the specimens show trademark use of applicant's mark; and the fact that third party rings are engraved with initials has little relevance here because applicant's mark functions as a symbol of the origin of the goods.

It is the Examining Attorney's position that consumers would perceive the proposed designation as a decorative or merely ornamental feature of the goods; that the size, location, dominance and significance of the proposed mark as applied to the goods must be considered in determining whether it is merely ornamentation; that the conspicuous use of initials on rings is a common and well-known form of ornamentation for such goods; and that applicant's argument that the three letters GRR are a combination of three

distinctive source indicating letters is unsupported by any evidence.

In support of her contention that the designation GRR does not indicate source, but rather is merely ornamental, the Examining Attorney submitted (i) printouts of two pages from a "Google" search for "rings with initials" (29,500 hits), and (ii) printouts from four web sites, specifically www.raru.com; www.custom-monograms.com; www.commerce.la-place-vendome.com; www.usastores.com, all to establish that signet or monogram rings frequently carry the initials of a person, school, business, fraternity, etc.; and that consumers are aware of such use. The Examining Attorney specifically contends that in this case, applicant's only use of his proposed mark is shown as initials prominently engraved on the surface of a signet ring; and that consumers would not perceive the initials as being the source of the ring but rather as mere ornamentation in the usual form of initials on the top plate of the ring.

The test when determining whether a mark is mere ornamentation, or ornamentation that also functions as an indicator of source, involves consideration of factors such as the size, location, dominance and significance of the alleged mark as applied to the goods. See *In re Pro-Line*

Corp., 28 USPQ2d 1141 (TTAB 1993). See also, TMEP §1202.03 (3d ed. 2002).

We agree with the Examining Attorney's conclusion that applicant's use of GRR as applied to jewelry (and particularly rings) would be perceived by consumers as merely an ornamental feature of the goods. The evidence submitted by the Examining Attorney shows that ornamenting rings with initials or monograms is common in the industry; but the record is devoid of any evidence that consumers would perceive these initials as indicating the source of the rings, rather than being perceived as simply the ornamental initials GRR. (For example, there is no evidence of applicant's use of GRR as a trademark for his goods such as use in advertisements, or placed on the inside of the ring band as a trademark, or on a box or label for the goods.) See *In re Pro-Line Corp.*, supra, (BLACKER THE COLLEGE SWEETER THE KNOWLEDGE for t-shirts, sweatshirts and shirts held mere ornamentation); *In re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988)(SUMO for t-shirts and baseball-style hats held mere ornamentation); *In re Astro-Gods Inc.*, 223 USPQ 621 (TTAB 1984)(ASTRO GODS and design for t-shirts held mere ornamentation); and *In re Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984)(YOU ARE SPECIAL TODAY for ceramic plates held mere ornamentation).

Cf. In re Watkins Glen International, Inc., 227 USPQ 727 (TTAB 1985)(a checkered flag design for various items of clothing and patches for application to clothing held to be an ornamental design, but also an indication of origin of the goods).

As a final matter, in his brief on appeal applicant raised for the first time a request that if registration of his mark on the Principal Register is denied, then "Applicant seeks the Board's approval to amend its [sic-his] application for registration on the Supplemental Register...." (Brief, p. 5.) The Examining Attorney objects to such action as it was not timely raised by applicant and the merits of such an amendment have not been addressed by the Examining Attorney.

Applicant has never actually filed an amendment requesting that the application be amended to seek registration on the Supplemental Register, and never requested it even as an alternative until his brief on the case. Inasmuch as this option was not raised by applicant until the time of his appeal brief, and hence this option was not considered by the Examining Attorney, we agree with the Examining Attorney's contention that this request came too late in the proceeding to remain an option for applicant. Applicant's request for leave to amend his

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application to the Supplemental Register is denied. See Trademark Rule 2.142(d); and *In re Petite Suites, Inc.*, 21 USPQ2d 1708 (Comm. 1991).

Decision: The refusal to register under Sections 1, 2 and 45 of the Trademark Act as mere ornamentation is affirmed.